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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------------|-------------------------|------------------|
| 09/717,278 | 11/22/2000 | Michelle Q. Wang Baldonado | 1508-3170 | 2069 |
| 7590 | 04/08/2004 | | EXAMINER | |
| Gunnar G Leinberg Esq Nixon Peabody LLP Clinton Square P O Box 31051 Rochester, NY 14603 | | | LESNIEWSKI, VICTOR D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2155 | |
| | | | DATE MAILED: 04/08/2004 | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|------------------------------|------------------------|-----------------------|
| | 09/717,278 | WANG BALDONADO ET AL. |
| Examiner | Art Unit | |
| Victor Lesniewski | 2155 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 22 November 2000.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-20 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 22 November 2000 is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ .

5) Notice of Informal Patent Application (PTO-152)

6) Other: ____ .

DETAILED ACTION

1. This application has been examined.
2. Claims 1-20 are now pending.

Priority

3. No claim for priority has been made in this application.
4. The effective filing date for the subject matter defined in the pending claims in this application is 11/22/2000.

Drawings

5. The drawings are objected to because the “monitor portion” of Figure 3 is labeled incorrectly. It is labeled as 260 where it should be 360. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

6. The disclosure is objected to because of the following informalities:
 - The summary heading on page 1, line 20 is in the wrong place. It should be either combined with the background heading on page 1, line 8 to read “Background and Summary of the Invention” or moved down one paragraph to page 1, line 30 where the background ends and the summary begins.
 - There is an error on page 3, line 22 where “message” should be “messages”.

- There is an improper incorporation of subject matter on page 4, lines 13-17 where two related, co-pending applications are made reference to, but not specified by an application number and thus, cannot be determined. Serial numbers for these applications are required in order to result in proper incorporation by reference.
- There is an error on page 6, line 4 where “chose” should be “choose”.
- There is an error on page 6, line 11 where “of” should be inserted between “stream” and “messages”.
- There is an error on page 12, line 13 where “is” should be removed.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 19 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

9. The specification fails to describe a data selection system that identifies an electronic message based on a sender based rule. See claim 19, line 3. The system

incorporating a sender based rule is hinted at in the summary on page 3, lines 29-33, but at no point in the specification is it mentioned again. While the current specification sufficiently describes a device that identifies an electronic message based on a sender-independent rule, there is no discussion of whether the system incorporating the sender-based rule functions in relatively the same manner or whether it is a completely unrelated system altogether. Thus, this system is not described in sufficient detail as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Scannell et al. (U.S. Patent Number 5,377,354), hereinafter referred to as Scannell.

12. Scannell disclosed a method and apparatus for prioritizing incoming email for a user, using a user created and modified rules-control. Scannell disclosed this system

wherein a screened message is sent to a folder. See the abstract. More specifically, Scannell disclosed an electronic message management system comprising:

Claim 19

- A data selection system that identifies at least one electronic message from a plurality of electronic messages based on a sender based rule (column 9, lines 40-47);
- An electronic message management system functionally associated with the data selection system, the electronic message management system adapted to communicate the at least one electronic message into a file (column 9, lines 53-56);

Claim 20

- The system wherein the data selection system samples a plurality of electronic messages (column 9, lines 48-53).

13. Since all the limitations of the invention as broadly set forth in claims 19 and 20 were disclosed by Scannell, claims 19 and 20 are rejected.

14. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Finney et al. (U.S. Patent Number 6,182,118), hereinafter referred to as Finney.

15. Finney disclosed a system for managing delivery of electronic messages according to the message recipient's preferences. See column 1, lines 10-13. In the background Finney acknowledged the existence of email systems that contain mechanisms by which users may define specific criteria and email systems in which this criteria allows users to take actions on messages such as sorting, discarding, and

forwarding. See column 1, lines 38-59. Finney went on to disclose his own invention that includes message selection criteria based on attributes of incoming messages and a distributor to apply the rules and carry out the user-specified actions. See column 2, lines 47-54. More specifically, Finney disclosed an electronic message management system comprising:

Claims 1, 7, and 13

- An information selection device that identifies an electronic message based on one or more sender-independent message-based rules (column 5, lines 15-16 and 43-44; figure 4, items 18 and 20);
- An electronic message management device that at least one of selects and integrates the electronic message into a digest or samples the electronic message (column 3, lines 54-67; figure 3, items 24, 30, 32, 36);

Claims 2, 8, and 14

- A digest management device that delivers the digest to a predetermined destination upon satisfaction of at least one of the one or more sender-independent message-based rules (column 5, lines 18-22; figure 2);

Claims 3, 10, and 16

- An information sampling device that delivers the sampled electronic message to a predetermined destination based on one or more of the sender-independent message-based rules (column 5, lines 18-22; figure 2);

Claim 4

- A rule management device that manages the one or more sender-independent message-based rules (column 5, line 17; figure 3, items 38 and 40);

Claims 5, 11, and 17

- The system wherein the one or more sender-independent message-based rules include a Boolean comparison, a statistical-based selection criteria, a fuzzy logic based selection criteria, a keyword based selection criteria, a date, a subject, a recipient, or a sender-based selection criteria (column 5, lines 32-42);

Claims 6, 12, and 18

- The system wherein the electronic message is at least one of an email, an electronic message from a mailing list, and a bulletin board posting (column 1, lines 14-25);

Claims 9 and 15

- The system wherein the digest is determined and updated based on one or more of the sender-independent message-based rules (column 5, lines 18-22; figure 2).

16. Since all the limitations of the invention as broadly set forth in claims 1-18 were disclosed by Finney, claims 1-18 are rejected.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure.

- Canale et al. (U.S. Patent Number 5,619,648) disclosed email filtering techniques wherein a recipient description containing non-address information is added to an email.
- Thurlow et al. (U.S. Patent Number 5,917,489) disclosed a system for creating, editing, and distributing rules for processing email.
- Paul (U.S. Patent Number 5,999,932) disclosed a system for filtering email using the identification data desired by the user.
- Elson (U.S. Patent Number 6,216,122) disclosed an email search folder device that organizes the user's email in accordance with attributes defined by the user.
- Hall, Robert J., "How to Avoid Unwanted Email," Communications of the ACM, ACM Press, March 1998, pgs. 88-95, disclosed email filtering agents used to discard messages that fail to satisfy user-defined criteria.
- Boone, Gary, "Concept Features in Re: Agent, an Intelligent Email Agent," International Conference on Autonomous Agents 1998, ACM Press, May 1998, pgs. 141-148, disclosed email filtering packages that use user-written rules to interpret and sort email.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 703-605-0643. The examiner can normally be reached on M-F 8:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam, can be reached at 703-308-6662. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VL

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